MAY 26 1970

JOHN F. DAVIS, CLERK

IN THE

Supreme Court of the United States

October Term, 1969

No. 1559

STOCKHAM VALVES AND FITTINGS, INC.,
Petitioner

v.

ARTHUR J. SCHMITT FOUNDATION and MORRIS BEAN & COMPANY,
Respondents

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

WILLIAM C. CONNER
Attorney for Respondent
530 Fifth Avenue
New York, N. Y. 10036

Of Counsel:

TRUMAN S. SAFFORD
GARO A. PARTOYAN
LEIGH M. CLARK
JAMES M. PARKER

TABLE OF CONTENTS

	PAGE
INTRODUCTION	1
Re: Petitioner's statement of "Questions Presented" and "Introductory Statement"	1
Re: Petitioner's "Statement of Facts"	3
Foundry Trade Journal article	3
Less et al. U. S. patent No. 2,662,067	4
The Abrasives Art	6
Alleged Contemporaneous Invention	6
ARGUMENT	7
The Bean '267 patent	7
The Bean '823 patent	8
The Applicable Law	9
CONCLUSION	10

TABLE OF CASES

Graham v. *John Deere Company*, 383 U. S. 1 (1966) 1, 9, 10

Williams Mfg. Co. v. *United Shoe Machinery Corp.*, 316 U. S. 364, 367 (1942) 9

In the

Supreme Court of the United States

October Term, 1969

No. 1559

Stockham Valves and Fittings, Inc.,
Petitioner

v.

Arthur J. Schmitt Foundation and
Morris Bean & Company,
Respondents

RESPONDENTS' BRIEF IN OPPOSITION TO PETITION FOR WRIT OF CERTIORARI

INTRODUCTION

This is a conventional action for patent infringement, in which petitioner seeks a review of findings of fact made by the District Court and affirmed by the Court of Appeals.

No issue of law is involved, since the lower courts expressly applied the standard of patentability enunciated by this Court in *Graham* v. *John Deere Company*, 383 U.S. 1 (1966).

Re: Petitioner's statement of "Questions Presented" and "Introductory Statement"

Instead of confining itself to a recitation of the issues involved, petitioner has included among the "Questions Presented" an argumentative and misleading statement

respecting the consideration of the prior art by the courts below.

Petitioner charges that both the District Court and the Court of Appeals "deprived Petitioner of a full and fair trial" by failing to consider the two most "strikingly pertinent" items of prior art, which resulted in a "miscarriage of justice." That charge is utterly groundless. In the District Court, petitioner cited a total of 57 items of prior art (39 patents and 18 publications) and actually introduced into evidence a total of 39 items, together with lengthy expert testimony explaining each of them (A-15, Finding 17). In its unusually detailed opinion, the District Court specifically discussed no less than 12 of these references, which the Court expressly found to be the "most relevant" of all the prior art relied upon (A-14 *et seq.*). The Court also expressly found that none of the other cited art disclosed or suggested the patented inventions (A-14, Finding 18).

On appeal to the Court of Appeals for the Fifth Circuit, petitioner designated for inclusion in the printed record 36 items of prior art. However, petitioner naturally focused attention upon those patents and publications whose relevance the District Court had not expressly deprecated in its opinion, petitioner making the identical charge which it makes here, that the District Court had failed to consider two important references, the *Foundry Trade Journal* article and the Less patent No. 2,662,067. With so much attention concentrated on these two references in the Court of Appeals, it is absurd to suggest that they were overlooked, merely because the Court of Appeals wrote only a *per curiam* opinion.

As will be seen, these two references did not even remotely approach a teaching of the patented invention.

Re: Petitioner's "Statement of Facts"

Foundry Trade Journal article

Contrary to the impression given by petitioner at pages 9 and 10, this 1949 article (A-66) does not relate to a foundry sand in which a resin is used to bind the grains together, as in the Bean process. Instead, it concerns a conventional *green sand,* in which moist bentonite clay serves as the binding material. The use of "wood resin" was suggested only to provide a filler material which would thermally decompose on contact with the molten metal and "provide carbon to form the gaseous film previously associated with coal dust." The object was to "eliminate coal dust" from the pulverized coal which had theretofore been added to green sand to provide the desired gaseous film during casting. The filthy coal dust which inevitably arose from the mix was said to be "the most objectionable feature in grey-iron foundry practice."

There is not a scintilla of evidence in the record that the unspecified type of "wood resin" the author had in mind would function as a binding material to hold the grains together and form a shell mold sufficiently strong to withstand the heat and hydrostatic pressure of the molten metal, and its erosive force on the surface grains as it surges into the mold cavity. The author certainly never used the resin in that way, nor taught any such use.

Moreover, the article states that the sand grains, after being coated with "wood resin" are baked in "a rotary dryer operating at approximately 200 deg. C. [392° F.] ***

to *set* the resin round the sand grains" during which operation, the resin "changed colour and was dark brown."

Thus, as the evidence showed, the resin had already been fully thermoset, so that it was incapable of softening and coalescing at the points of contact of the sand grains to bind them together into a rigid mold.

Finally, the green sand described in the article was not "dry and free-flowing" as claimed in the Bean patents, and could not be dropped onto a pattern to form a shell mold perfectly conforming to every surface detail of the pattern. Just the contrary, the article expressly states that the sand was made "slightly tacky" and that "bentonite [clay] was added with the right amount of water to obtain the bond required."

It is obvious why the District Court found this publication less relevant than any of those which the Court expressly discussed.

Less et al. U. S. patent No. 2,662,067

The Less patent (A-64) concerns an attempt to eliminate one of the disadvantages of the old Croning process—the segregation of resin dust from the sand grains which not only resulted in "a very dusty operation" but also "nonuniformity in the molds and the castings made therefrom."

The solution proposed by Less was to moisten the sand with a *non-evaporating* liquid "adhesion agent," such as glycerine or ethylene glycol before the powdered resin was added, with the objective of causing the powdered resin to adhere to the moistened grains.

This clearly does not result in dissolving of the powdered resin to form "substantially continuous * * * envel-

oping films'' of resin—a ''dry, lacquer-like coating over each of the grains''—as disclosed and claimed in the Bean '267 patent.

The proposal of Less is nothing more than the so-called ''wetting agent'' method of attempting to stick the powdered resin to the moistened sand grains with which Ford Motor Co. experimented unsuccessfully for a number of years, as the Courts below specifically found (A-10, Finding 9). Indeed, the ''wetting agents'' which Ford attempted unsuccessfully to use included both glycerine and glycols, the very materials proposed by Less.

The Less patent thus proves nothing except that others had recognized the serious shortcomings of the Croning process and had attempted unsuccessfully to overcome them.

Incidentally, the application which resulted in the Less patent was not filed until April 12, 1951, four months *after* the filing of the original application for the Bean '267 patent. In an attempt to carry Less's filing date back ahead of Mrs. Bean's, petitioner relies upon an earlier abandoned application of Less, filed December 27, 1949, of which Less's later application was said to be a ''continuation-in-part.'' However, Less was not entitled to the claimed benefit of the earlier filing date because of a complete changeover in the materials employed in the examples disclosed in the two applications. In the only specific example given in the original application, tri-cresyl phosphate was employed as the ''adhesion agent.'' This material was dropped altogether from Less's later application, for the obvious reason that it didn't work. Indeed, tricresyl phosphate was another of the materials which Ford

Motor Co. had unsuccessfully tried in its ill-fated "wetting agent" tests.

Thus, in Less's second application he merely switched from one unworkable material to two others. And, whether he succeeded or didn't, Less never even attempted—indeed never dreamed of—*dissolving* the resin in a solvent, coating the sand with the resulting solution, then evaporating the solvent to leave a "lacquer-like" coating of resin on each individual sand grain, as Mrs. Bean did.

The Abrasives Art

The abrasives art, which is referred to at pages 11 and 12 of the petition, was thoroughly discussed by the District Court in its Findings 18 through 21 (A-14 through A-20). We see no need to add anything to the Court's statement of the reasons why this art fell far short of teaching the patented invention. Neither did the Court of Appeals.

Alleged Contemporaneous Invention

Petitioner's statements, at pages 12 and 13, as to the alleged contemporaneous invention by others, are contrary to the findings of the District Court respecting the unsuccessful efforts of Ford Motor Co. (A-10, Finding 9), National Engineering Co. (A-21, Finding 23) and Monsanto (A-21, Finding 22), all of which were fully confirmed by the Court of Appeals.

ARGUMENT

The Bean '267 patent

Having thus misdescribed the prior art, petitioner proceeds, in its Argument, at pages 15 *et seq.*, to misdescribe even the patented invention.

Petitioner states that the patented invention consists of sand grains having only three characteristics: (1) they are dry and free-flowing; (2) they are individually coated with resin; and (3) the resin is thermosetting. Petitioner has pointedly omitted a number of other important limitations appearing in the patent claims. For example, various claims of the Bean '267 patent also require that the sand grains be "substantially round" (which abrasive grains should never be), that the amount of resin binder be "substantially 1% to 4% by weight of the sand" and that the resin films be "substantially continuous", "completely enveloping" and "approximately 0.0001 inch" in thickness (which it never is in grinding wheels). Finally, and most importantly of all, the claims require that these films of resin, so thin and transparent they can't be seen even with the most powerful optical microscope, and so "dry and non-tacky" that when dropped onto a pattern, "without application of external pressure," the grains can instantly and perfectly conform to the most intricate surfaces of the pattern, then, when heated briefly, these sub-microscopic films will first melt and "coalesce," then thermoset and harden "for bonding said individual granules at points of contact thereamong to form a rigid mold" which is strong enough to withstand the pressure of molten metal.

There is not a single one of the prior art compositions which was shown to be capable of functioning in this way.

Indeed, as the District Court found, tests conducted by both parties showed that even when the prior art mixtures were modified in the light of the teachings of the Bean patents, by changing the type and size of the grains and the amount of resin, and even when an extra mulling step was added to break up the grains after they had stuck together (showing they were not "non-tacky" and "free-flowing" as the claims require) these modified mixtures *still* could not be used in the manner contemplated by the Bean patents (Findings 18a-f and 21, A-14 through A-20).

Petitioner's excuse, at pages 16 and 17, for disregarding all of these other limitations in the claims was merely that Mrs. Bean's attorney, in distinguishing certain of the prior patents cited by the Patent Office, had mentioned only the three claim limitations first enumerated above. But it was obviously unnecessary to catalog *every* difference from the prior art, which had already been amply distinguished in these three respects.

Thus, petitioner's argument that the prior art fully "anticipates" the invention of the Bean '267 patent, consists only of the application of erroneously described prior art to an incompletely described invention.

The Bean '823 patent

Curiously, petitioner did not mention the Bean '823 patent even once in its entire argument, although the District Court and the Court of Appeals concurred in ruling this patent both valid and infringed.

The petition thus leaves unchallenged respondents' right to an injunction against petitioner's infringement of the

Bean '823 patent. Petitioner's attempt to have its same acts declared free of infringement of the Bean '267 patent thus presents a moot case.

The Applicable Law

In its "Reasons for Granting the Writ," and again in its "Conclusion" petitioner attempts to create the appearance of an error of law justifying the attention of this Court, by arguing that the District Court failed to apply the standards of patentability established in *Graham* v. *John Deere,* 383 U.S. 1 (1966). That is a most surprising contention, since the District Court quoted directly from this Court's opinion in *Graham,* and proceeded to apply the criteria of patentability there enunciated to the facts found by the Court (A-34, 35).

Petitioner actually seeks only a review of findings of fact which were concurred in by both of the courts below. This Court has repeatedly ruled that it will not grant certiorari to review such concurrent findings if there is any evidence to support them. *Williams Mfg. Co.* v. *United Shoe Machinery Corp.,* 316 U.S. 364, 367 (1942) and cases cited therein.

CONCLUSION

It is clear that there is no need for this Court to reiterate the rule of *Graham*, and that the "uniform interpretation and application * * * of the patent laws" which petitioner professes to seek has already been achieved in this case, to petitioner's chagrin.

The petition should be denied.

Respectfully submitted,

WILLIAM C. CONNER
Attorney for Respondent
530 Fifth Avenue
New York, N. Y. 10036
(212) 682-7171

Of Counsel:

TRUMAN S. SAFFORD
GABO A. PARTOYAN
CURTIS, MORRIS & SAFFORD
New York, N. Y.

LEIGH M. CLARK
CABANISS, JOHNSTON, GARDNER & CLARK
Birmingham, Alabama

JAMES M. PARKER
GARY, PARKER, JUETTNER & CULLINAN
Chicago, Illinois

CERTIFICATE OF SERVICE

I certify that five (5) copies of the foregoing Brief were delivered to Thomas F. Reddy, Jr., attorney for petitioner, at 330 Madison Avenue, New York, N. Y. this 25th day of May, 1970.

WILLIAM C. CONNER
Attorney for Respondent